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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/796,519	02/07/1997	HIROYUKI INOUE	684.2213-DIV	9056

7590 07/01/2002
FITZPATRICK CELLA
HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10172

EXAMINER

HALLACHER, CRAIG ALAN

ART UNIT PAPER NUMBER

2853

DATE MAILED: 07/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/796,519

Applicant(s)

INOUE ET AL.

Examiner

Craig A Hallacher

Art Unit

2853

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43-57, 60, 65, 72-101, 116-133 and 149-206 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43-57, 60, 65, 72-101, 116-133 and 149-206 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 28.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Continued Prosecution Application

2. The request filed on 5/22/02 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/796,519 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 43-57, 60, 65, 72-101, 116-133 and 149-206 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 43-57, 60, 65, 72-101, 116-133 and 149-206 are rejected for being unduly multiplied as containing an unreasonable number of claims so as to confuse the issue. That is

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approximately 256 claims is deemed to be unreasonable number of claims in view of the nature and scope of applicant's invention, primarily an ink container for use in an inkjet printer. See the attached claim tree for the number of claims. Furthermore, it appears that there may different inventions being claimed that are subcombinations useable together. For example, it appears as if an ink cartridge and a device for holding an ink cartridge are both claimed. However, due to the sheer number of claims, it can not be ascertained as to whether claims linking the subcombinations are being claimed. Thus, it is not clear as to whether multiple inventions are being claimed or not. Also, throughout the history of the prosecution, there has been no evidence provided as to the need of 250+ claims to describe the invention. The Applicant should limit the number of claims of to the elected invention to 42. See M.P.E.P. 2173.05(n).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Craig A Hallacher whose telephone number is (703)308-0516. The examiner can normally be reached on M-F (8:30-6:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow, Jr. can be reached on (703)308-3126. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3432 for regular communications and (703)305-3432 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-3431.

C.A.H.
July 1, 2002



CRAIG HALLACHER
PRIMARY EXAMINER

Renumbering of Claims

Attachment to Paper # 28

The claims have been renumbered as indicated below in accordance with 37 CFR 1.126 and MPEP §§ 608.01(n) and 1302.01.

- ⊖ 43 → 1
 - └ 44 → 2
 - └ 45 → 3
 - └ 46 → 4
 - └ 47 → 5
 - └ 48 → 6
 - └ 49 → 7
 - └ 50 → 8
 - └ 51 → 9
 - └ 52 → 10
 - └ 53 → 11
 - └ 54 → 12
 - └ 55 → 13
 - └ 56 → 14
 - └ 57 → 15
 - └ 60 → 16
 - └ 65 → 17
 - ⊖ 69 → 18
 - └ 70 → 19
 - └ 72 → 20
 - ⊖ 150 → 21
 - └ 68 → 22
 - └ 151 → 23
 - └ 152 → 24
- ⊖ 73 → 25
 - └ 74 → 26
 - └ 75 → 27
 - ⊖ 76 → 28
 - └ 86 → 29
 - └ 77 → 30
 - └ 78 → 31
 - └ 79 → 32
 - ⊖ 80 → 33
 - └ 83 → 34
 - ⊖ 81 → 35
 - └ 99/81 → 52
 - ⊖ 82 → 36
 - └ 84 → 37
 - └ 85 → 38
- ⊖ 87 → 39
 - └ 10 → 40
 - └ 88 → 41
 - └ 89 → 42

- 90 -> 43
- 91 -> 44
- 92 -> 45
- 93 -> 46
 - 94 -> 47
- 95 -> 48
- 96 -> 49
- 97 -> 50
- 98 -> 51
 - 99/98 -> 52
- 100 -> 53
- 153 -> 54
- 116 -> 55
 - 117 -> 56
 - 118 -> 57
 - 119 -> 58
 - 120 -> 59
- 121 -> 60
 - 122 -> 61
 - 123 -> 62
- 124 -> 63
 - 125 -> 64
 - 126 -> 65
 - 127 -> 66
 - 128 -> 67
 - 129 -> 68
 - 130 -> 69
- 131 -> 70
- 132 -> 71
- 133 -> 72
- 149 -> 73
- 154 -> 74
 - 155 -> 75
 - 177/155 -> 97
 - 178/177/155 -> 98
 - 179/178/177/155 -> 99
- 156 -> 76
 - 177/156 -> 97
 - 178/177/156 -> 98
 - 179/178/177/156 -> 99
- 157 -> 77
 - 177/157 -> 97
 - 178/177/157 -> 98
 - 179/178/177/157 -> 99
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 - 177/158 -> 97
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166 -> 86
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 - 206/205/204/185 -> 126
 - 186 -> 106
 - 204/186 -> 124
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 - 206/205/204/186 -> 126
 - 187 -> 107
 - 204/187 -> 124

- ☐ 205/204/187 -> 125
 - └ 206/205/204/187 -> 126
- ☐ 188 -> 108
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 - ☐ 204/189 -> 124
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- ☐ 199 -> 119
 - ☐ 204/199 -> 124

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